

1 independent Claims 1, 14, and 20, as well as certain dependent claims stemming therefrom, were
2 rejected under 35 U.S.C. § 102(b). Finally, Claim 33 was rejected under 35 U.S.C. § 103(a).
3 Claims 1, 2, 7, 14, and 15 have been amended above to clarify the invention.

4 In view of the above amendments and the remarks set forth below, applicant respectfully
5 requests reconsideration and submits that all claims are now in condition for allowance.

6 Claim Objection

7 Claim 30 was objected to because of the phrase "without contacting either the carrier frame or
8 the elastomeric layer to limit the amount of vibrational energy..." is capable of two distinct and diverse
9 interpretations. The Office sets forth the position that the claimed purpose of lack of contact could be
10 to limit the vibration; additionally, the purpose of the contact could be to inhibit the vibration. In view
11 of the following comments, applicant respectfully traverses this objection.

12 Claim 30 generally recites that the shoe portion may be further isolated from vibration
13 associated with traversing a surface by limiting the attachment of the shoe portion 22 to only the outer
14 shell 166. Page 9, lines 27-29. As seen in Figure 4, the carrier frame 170 and the elastic layer 168 do
15 not extend into the area adjacent the perimeter of the attachment holes 60a and 60b (see Figure 1).
16 Page 9, lines 29-31. The shoe portion 22 is fastened to the frame 120 by a bolt 172 extending through
17 the attachment hole without contacting either the elastic layer 168 or the carrier frame 170, thereby
18 eliminating a direct load path to the shoe portion 22. Page 9, lines 31-34. Thus, it is the lack of contact
19 between the shoe portion 22 and both the carrier frame 170 and the elastic layer 168 that eliminates a
20 direct load path therebetween to further isolate the shoe portion 22 from vibration associated with
21 traversing a surface.

22 As a result of the foregoing, applicant respectfully submits that the objection to Claim 30 has
23 been overcome.

24 Rejections Under 35 U.S.C. § 102(e)

25 Claim 1 stands rejected under 35 U.S.C. § 102(e) as being anticipated by any one of the
following: U.S. Patent No. 5,934,692, issued to Artus; U.S. Patent No. 5,938,214, issued to Roman

1 et al.; U.S. Patent No. 5,934,693, issued to Nicoletti; or U.S. Patent No. 5,810,369, issued to Wilder
2 et al. Claims 14-16 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Artus. Finally,
3 Claims 20, 21, 26-28, 32, and 34 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Artus.
4 Applicant respectfully submits that none of the foregoing claims, as amended, are anticipated by any of
5 the cited references.

6 A. U.S. Patent No. 5,934,692, Issued to Artus

7 Independent Claims 1, 14, 20, 26, and 34, as well as certain dependent claims stemming
8 therefrom, stand rejected under 35 U.S.C. § 102(e) as being anticipated by Artus. In response to this
9 rejection, applicant respectfully submits a Declaration under 37 C.F.R. § 1.131, filed herewith, to
10 antedate the reference.

11 As set forth in the Declaration, applicant asserts that the invention, as set forth in each of the
12 foregoing claims, was conceived in the United States prior to the December 9, 1996 filing date of Artus.
13 Applicant further submits that he acted with due diligence from a date prior to the December 9, 1996
14 filing date of Artus until the invention was constructively reduced to practice by the filing of the present
15 application for patent on September 1, 1998. Therefore, applicant respectfully traverses the rejection of
16 each of the foregoing claims under 35 U.S.C. § 102(e) for at least the reason that Artus is not prior art.

17 B. U.S. Patent No. 5,938,214, Issued to Roman et al.

18 Claim 1 stands rejected under 35 U.S.C. § 102(e) as being anticipated by Roman et al.
19 Applicant respectfully disagrees. In this regard, and referring to FIGURE 7, Roman et al. teach a
20 skate 1 having a shoe 2 and a frame 7. The frame 7 includes first and second shells 8 and 9 having
21 bars 10a and 10b. The bars 10a and 10b have a shaped lower surface for accommodating a plurality of
22 wheels 14. A plurality of separate wings 15a and 15b protrude below each bar 10a and 10b and are
23 approximately S-shaped. The free ends 16a and 16b of the wings 15a and 15b are arranged on planes
24 that are approximately perpendicular to the bars 10a and 10b. The wings 15a and 15b are contained in
25 the space between a first median plane 29 lying longitudinally to the frame 7 and a second plane 30 that
is tangent to the lateral surface 26 of the wheels 14 and to the lateral surface 31 of the boot shell 3.

1 As best seen by referring to Figure 2 of Roman et al., the configuration of the wings 15a
2 and 15b allows the formation, between the contact plane 32 of the wheel 14 and the second plane 30,
3 which is tangent to the lateral surfaces 26 of the wheel 14, an angle β which is larger than the angle
4 achieved by prior art skates. Column 3, lines 26-32. Thus, Roman et al. merely teaches a skate having
5 inclined sidewalls for improved turns and side slip braking.

6 Applicant respectfully submits that Roman et al. do not anticipate the invention of amended
7 Claim 1. In this regard, Roman et al. do not teach or suggest a skate frame having *flexible* vibration
8 dampening means for absorbing at least a portion of vibrational energy associated with traversing a
9 surface, as now generally recited in amended independent Claim 1. Roman et al., on the other hand,
10 merely teach a skate having inclined sidewalls for improved turning and braking performance. Further,
11 there is no teaching or suggestion in Roman et al. of vibration dampening means integrally formed with
12 the sidewalls of a first structural member of a skate frame, as generally recited in Claim 1 as originally
13 filed. As a result, applicant respectfully submits that amended Claim 1 is not anticipated by Roman
14 et al.

15 Applicant also respectfully submits that the disclosure of Roman et al. fails to teach or suggest a
16 skate frame in accordance with the present invention of amended Claim 1. Nowhere do Roman et al.
17 teach or suggest a need or desire of a skate frame having a flexible vibration dampening means
18 integrally formed with the sidewalls of the first structural member of the skate frame, as now recited in
19 amended Claim 1. Furthermore, there is absolutely no teaching or suggestion within Roman et al. of
20 vibration dampening means, flexible or otherwise, for absorbing at least a portion of vibrational energy
21 associated with traversing a surface. Instead, Roman et al. merely teach a skate frame having inclined
22 sidewalls for improved turning and braking performance. Hence, applicant respectfully submits that
23 Roman et al. fail to teach or suggest the subject matter of independent Claim 1 and, therefore, Claim 1
24 is also nonobvious in view of the disclosure of Roman et al.
25

1 C. U.S. Patent No. 5,934,693, Issued to Nicoletti

2 Independent Claim 1 also stands rejected under 35 U.S.C. § 102(e) as being anticipated by
3 Nicoletti. Nicoletti discloses a skate frame 1 having two parallel sides 8 and 9. The sides 8 and 9 are
4 spaced and fixed to blocks 3 and 4. The blocks 3 and 4 are adapted to receive the heel and toe end,
5 respectively, of a skate boot. Wheels 11a-11d are received between the sides 8 and 9 by pins 10a-10d.
6 Each block 3 and 4 is movable longitudinally along the sides 8 and 9. The blocks 3 and 4 can be
7 positioned adjustably along the sides 8 and 9 to accommodate shoes of different sizes. Thus, Nicoletti
8 teaches a skate frame having sidewalls slidably connected to heel and toe attachment members to
9 accommodate a variety of different-sized footwear.

10 Applicant respectfully submits that the longitudinally adjustable skate frame of Nicoletti does
11 not anticipate the invention of amended independent Claim 1. Nicoletti does not teach or suggest a
12 skate frame having flexible vibration dampening means integrally formed with the sidewalls of the first
13 structural member of the skate frame, as now recited in amended Claim 1. Further, Nicoletti does not
14 teach a skate frame having flexible vibration dampening means for absorbing at least a portion of
15 vibrational energy associated with traversing a surface, as recited in amended Claim 1. Accordingly,
16 because Nicoletti does not teach or suggest a skate frame having flexible vibration dampening means
17 integrally formed with sidewalls of the skate frame, applicant respectfully submits that amended
18 Claim 1 is not anticipated by Nicoletti.

19 Applicant further submits that amended Claim 1 is also nonobvious over the disclosure of
20 Nicoletti. In this regard, there is no teaching or suggestion of a skate frame having flexible vibration
21 dampening means integrally formed with the sidewalls of the skate frame, as now generally recited in
22 amended Claim 1. Further, there is absolutely no teaching or suggestion in Nicoletti of any type of
23 vibration dampening means, let alone flexible vibration dampening means integrally formed with the
24 sidewalls of the first structural member of the skate frame, as now recited in Claim 1. Instead, Nicoletti
25 merely teaches a skate frame having sidewalls longitudinally slidable to accommodate different sized

1 footwear. As a result, applicant respectfully submits that Claim 1, as amended, is also not obvious in
2 view of the disclosure of Nicoletti.

3 D. U.S. Patent No. 5,810,396, issued to Wilder et al.

4 Claim 1 further stands rejected under 35 U.S.C. § 102(e) as being anticipated by Wilder et al.
5 Wilder et al. teach a skate frame 10 having toe and heel attachment members 12 and 14. A pair of
6 longitudinal members 20 and 22 extend downwardly below the attachment members 12 and 14 along
7 the longitudinal axis of the frame 10. The longitudinal members 20 and 22 form an "A"-shaped frame
8 when viewed from the front or rear. As best seen by referring to Figures 4 and 5, a web having lateral
9 sections 36 and 37 extends below the attachment members 12 and 14 to *connect and strengthen* the
10 longitudinal members 20 and 22. Column 3, lines 2-3 (emphasis added). Note that there is no teaching
11 or suggestion of flexibility with regards to the frame 10. Thus, Wilder et al. teach a skate frame having
12 webs extending between the sidewalls of the frame for improved strength.

13 Applicant respectfully submits that the frame of Wilder et al. does not anticipate the invention
14 of amended Claim 1. Wilder et al. fail to teach or suggest a skate frame having flexible vibration
15 dampening means for absorbing at least a portion of vibrational energy associated with traversing a
16 surface, as now generally recited in amended Claim 1. Instead, Wilder et al. merely teach a skate frame
17 having webs extending laterally between first and second sidewalls of the skate frame to "strengthen"
18 the sidewalls 20 and 22. As a result, applicant respectfully submits that Claim 1, as amended, is not
19 anticipated by Wilder et al.

20 Applicant further submits that the invention of Claim 1 is also nonobvious over the disclosure of
21 Wilder et al., whether taken alone or in combination with the other references of record. As noted
22 above, Wilder et al. fail to teach or suggest a skate frame having a flexible vibration dampening means
23 integrally formed with the sidewalls of the first structural member of the skate frame to absorb at least a
24 portion of vibrational energy associated with traversing a surface, as now generally recited in Claim 1.
25 Wilder et al., instead, teach a skate frame having webs extending laterally between the sidewalls of the
skate frame for strengthening the skate frame. This is contrary to the present invention of Claim 1,

1 wherein a flexible vibration dampening means is integrally formed with the sidewalls to absorb at least
2 a portion of the vibrational energy of traversing a surface. Thus, applicant respectfully submits that
3 Wilder et al. fails to teach or suggest the invention of amended Claim 1.

4 Rejections Under 35 U.S.C. § 102(b)

5 Independent Claims 1, 14, and 20, as well as certain dependent claims stemming therefrom,
6 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,092,614, issued to
7 Malewicz. Applicant respectfully disagrees.

8 Malewicz teaches an inline roller skate having a frame that includes a pair of side rails 32
9 and 34, each side rail having front and rear mounting brackets for attachment of the frame to the boot of
10 the inline roller skate. Each rail 32 and 34 includes a curved portion 130 and 160. Each curved
11 portion 130 and 160 is defined by a convex outer side 132 and 162, respectively, and a concave inner
12 side 136 and 166, respectively. The curved portion of each rail 32 and 34 includes front and rear
13 convex upper edges 200, 204, 210, and 214, respectively, that define mounting surfaces for engaging
14 the boot sole and which lie substantially flush with and bear against the outer sole 48 when the frame 14
15 is mounted to the boot 12. The front and rear mounting surfaces 200, 204, 210, and 214 contribute to a
16 safe, enjoyable operation for a skater by *resisting* side to side flexing of the frames. Column 11,
17 lines 30-32 (emphasis added). Additionally, the frames of Malewicz, which *include* the curved
18 portions 130 and 160, in general provide a more stable structure than prior art "because they *resist*
19 lateral twisting and *flexing*" better than prior art frames. Column 11, lines 35-39 (emphasis added).
20 Thus, Malewicz teaches an inline skate frame having curved portions to resist flexing.

21 Applicant respectfully submits that the skate frame of Malewicz does not anticipate the
22 invention of Claims 1 and 14, as amended, and Claim 20 as originally filed. Malewicz fails to teach or
23 suggest a skate frame having a *flexible* vibration dampening means for absorbing at least a portion of
24 vibrational energy associated with traversing a surface, as now generally recited in amended Claims 1
25 and 14, and as generally recited in Claim 20 as originally filed. Additionally, Malewicz fails to teach or
suggest first and second structural members each having downwardly depending sidewalls, wherein the

1 sidewalls of the second structural member are spaced to receive the first structural member
2 therebetween such that the sidewalls of the second structural member overlap at least a portion of the
3 sidewalls of the first structural member, as originally recited in Claim 14. Finally, Malewicz fails to
4 teach or suggest sidewalls of a carrier frame and an outer shell having a predetermined cross-sectional
5 shape to permit the sidewalls to flex, as originally recited in Claim 20. Thus, for each of the foregoing
6 reasons, applicant respectfully submits that Claims 1, 14 and 20 are not anticipated by Malewicz.

7 Applicant further submits that amended Claims 1 and 14, and Claim 20 are also nonobvious
8 over the disclosure of Malewicz. In this regard, there is no teaching or suggestion of a need or desire
9 for flexible vibration dampening means integrally formed with the sidewalls of the first structural
10 member of the skate frame for absorbing at least a portion of the vibrational energy associated with
11 traversing a surface, as now generally recited in amended Claim 1. Malewicz also fails to teach or
12 suggest the need or desire of a skate frame having a vibration dampening member that is flexible,
13 thereby absorbing at least a portion of the vibrational energy associated with traversing a surface, as
14 now generally recited in amended Claim 14. Further, there is absolutely no teaching or suggestion
15 within Malewicz of the need or desire of a skate frame that includes sidewalls having a predetermined
16 cross-sectional shape to permit the sidewalls to flex, thereby absorbing at least a portion of the
17 vibrational energy transmitted from the surface to the shoe portion when the skate traverses the surface,
18 as originally recited in Claim 20. In fact, Malewicz expressly teaches away from flexible sidewalls,
19 wherein the sidewalls of Malewicz are expressly described as resisting lateral twisting and flexing.
20 Column 11, lines 38-39. Accordingly, applicant respectfully submits that Claims 1, 14 and 20 are also
21 nonobvious over the disclosure of Malewicz.

22 Rejections Under 35 U.S.C. § 103

23 Claim 33 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Artus in view of
24 Malewicz. The Office sets forth the position that the method of Claim 33 is an inherently obvious
25 method of the structure set forth in Claim 29 of the pending application and is rejected accordingly.
Applicant respectfully disagrees for at least the following reasons.

1 First, as set forth in greater detail above with regard to the declaration under 37 C.F.R. § 1.131,
2 applicant respectfully submits that Artus is not prior art and, therefore, may not be used as a basis for a
3 rejection under 35 U.S.C. § 103(a). With regard to Malewicz, applicant respectfully submits that there
4 is absolutely no teaching or suggestion of a skate frame having an outer shell with first and second
5 sidewalls spaced to receive a carrier frame therebetween, such that the sidewalls of the outer shell
6 overlap at least a portion of the sidewalls of the carrier frame, as generally recited in independent
7 Claim 26, from which Claim 29 depends. Further, applicant respectfully submits that Malewicz is
8 silent with respect to a skate frame having an elastomeric shear layer disposed between the carrier
9 frame and the outer shell to absorb at least a portion of vibrational energy associated with traversing a
10 surface, as is also recited in Claim 26 as originally filed. Instead, Malewicz merely teaches a skate
11 frame having sidewalls that are configured to resist lateral twisting and flexing.

12 Accordingly, there is no teaching or suggestion within Malewicz of a skate frame in accordance
13 with Claim 26 as originally filed and, therefore, Claim 26 is not obvious in view of Malewicz. As a
14 result, because Claim 29 depends from Claim 26, applicant respectfully submits that Claim 29 is also
15 not obvious in view of Malewicz, whether taken alone or in hypothetical combination with the other
16 references of record. Furthermore, because Claim 29 is not obvious in view of the teachings of Artus
17 and Malewicz, applicant submits that the method of Claim 33 is also nonobvious. Applicant also notes
18 that Claim 33, as originally filed, includes the step of contouring the cross-sectional shape of the outer
19 shell to permit the sidewalls of the outer shell to flex, thereby absorbing at least a portion of vibrational
20 energy associated with traversing a surface. Applicant respectfully submits that there is absolutely no
21 teaching or suggestion with Malewicz of such a limitation.

22 Hence, because Artus has been disqualified as prior art, and because Malewicz teaches directly
23 away from the invention of Claim 33, as well as fails to teach or suggest a recited step of Claim 33,
24 applicant respectfully submits that Claim 33, as originally filed, is not obvious in view of a hypothetical
25 combination of Artus and Malewicz.

1 Applicant respectfully submits that the dependent claims of the present application are
2 allowable for at least the reasons discussed above. Additionally, the dependent claims have further
3 limitations that distinguish over the foregoing references, whether taken individually or in combination.
4 Therefore, applicant respectfully submits that the dependent claims of the present application should
5 also now be found allowable.

6 CONCLUSION

7 In light of the foregoing amendments and remarks, applicant respectfully submits that the
8 present application is now in condition for allowance. Applicant respectfully requests entry of the
9 amendments and reconsideration and allowance of all claims. The Examiner is invited to telephone the
10 undersigned attorney if there are any remaining issues.

11
12 Respectfully submitted,

13 CHRISTENSEN O'CONNOR
14 JOHNSON & KINDNESS^{PLLC}

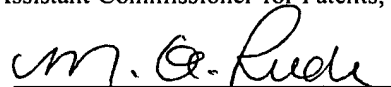
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